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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,633	11/01/2006	Robert Neugebauer	NEUGEBAUER ET AL-2 PCT	9729
25889 7590 07/21/2009 COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576				
EXAMINER REICHEL, KARIN M				
ART UNIT		PAPER NUMBER		
3761				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/589,633

Applicant(s)

NEUGEBAUER ET AL.

Examiner

Karin M. Reichle

Art Unit

3761

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6-16-09 has been entered, except as noted infra.

Response to Amendment

2. The amendments to the specification, filed 5-18-09 and 6-16-09, except for the separately presented abstract filed 5-18-09, have not been entered as they did not comply with 37 CFR 1.121. Those filed 5-18-09 were not entered for the reasons set forth in the 6-1-09 and 6-5-09 communications. The amendments filed 6-16-09 request the cancellation of all previously added paragraphs above line 1, i.e. that added by the first preliminary amendment, and the amendment of the first paragraph as set forth on page 2 of the 6-16-09 response. But such amended "paragraph" [1] adds three subtitles and a cross reference paragraph and therefore is not an amended "paragraph" [1]. It is also noted that such amendments to the "paragraph" were not underlined. The next response, if any, could resubmit the amendments but after the cancellation on lines 2-3 request insertion of the three subtitles/headings and the new paragraph, i.e. similar to that on page 2, last three lines, and then request amendment to the first paragraph and submit the amended paragraph [1]/now paragraph [01.1], similar to the request and amendment of

paragraph 2 on page 3 of the 6-16-09 response. Also the entire paragraph 34 should be presented with the amendments shown thereto not only sections/paragraphs thereof on page 13. Therefore see discussion infra. With regard to the Figures, see also discussion infra.

Specification

Drawings

3. The drawings were received on 5-18-09. These drawings are not approved. First there was no original sheet 5 so such sheet is not a "REPLACEMENT SHEET" but rather a "NEW SHEET". The response does not include annotated Figures/original sheets 1/ 4- 4/4 nor a detailed explanation of all changes to the drawings in either the drawing amendment or remarks section of the amendment paper. For example, where is the removal of "M" on sheet 1 of 4, Figure 1 set forth? The removal of the text in Figure 6d? Therefore see the following paragraphs.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must

be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because Figure 2 and the description thereof are inconsistent, i.e. as best understood, Figure 2, shows more than just a cutting line, i.e. appears to show strips 1 and 2. In Figure 6c, the lines from 11 should be dashed. In Figure 3, 13 does not denote the user end. In Figure 6d, the line from the uppermost 11 should be dashed. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

6. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: paragraph 2.

7. The disclosure is objected to because of the following informalities: The paragraph added before line 1 on page 1 should also include a paragraph number. The various sections of the application should be identified in accordance with 37 CFR 1.77(b). In Figure 3, what is "VI"? At the very least, see also discussion *infra* in paragraphs 8-9 *infra*, the description of the separate grip area throughout the application, e.g. on the last two lines of claim 1 and 26-28 as compared to paragraphs 19 and 48, is unclear/inconsistent.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. Claims 1-16 and 24-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, the last two lines are unclear, i.e. is Applicant claiming the area had hooks at some point, i.e. “no remaining hooks”? If so, positive structural antecedent basis for such hooks which no longer remain should be set forth. Also, as discussed *infra*, it is noted that the claims are drawn to end products, not processes of manufacturing such, see MPEP 2113. These remarks also apply to similar language in claim 26. In regard to claim 5, the surface of what? The grip area? The hygiene item?

9. Claims 1-6, and 24-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 26 now require a separate grip area having no remaining hooks in combination with the other structure set forth in the respective claim. Note the discussion in the preceding paragraph. Applicant relies upon paragraph 19 to support such amendment. However, while paragraph 19 discloses a grip area of a film which requires no after treatment, this is not what is claimed. Furthermore, note again the discussion of product by process both *infra* and *supra*. The lack of support is further exacerbated by the lack of clarity set forth in the preceding paragraph. Claims 27 and 28 now require a separate grip area of a “different” material than the closing area in combination with the other structure set forth in the respective claim. Note the discussion of the scope of the terminology “different” in paragraphs 10 and 12 *infra*. Applicant relies upon paragraph 48 to support such amendment. However, while paragraph 48 discloses a grip area of a film or film with macroscopically structured surface and a closing area which is formed by hook material having hooks, and thereby of “different” material, this is not

what is claimed. If Applicant maintains the claim language, the portion of the original application which provides support of commensurate scope in a single embodiment for the combination of each of the claims should be set forth.

Claim Language Interpretation

10. Other than the claim language “like a film” set forth in paragraph 18, the remainder of the claim language has not been explicitly and thereby will be given its usual, e.g. dictionary, definition. “Separate” as defined by the dictionary is “to space apart; scatter” and “macroscopic” is defined as “large enough to be perceived or examined without instrumentation, esp. as by the unaided eye” (See also Response to Arguments section in the 12-16-08 FINAL). With regard to the claims and paragraph 9, see MPEP 2163.06, I. Furthermore in light of such paragraph as well as paragraphs 7-8, claims 1 and 26, are interpreted as product by process claims due to the added language of the last two lines, see MPEP 2113. Therefore, the end product of such claims, as best understood, has a grip area with no hooks. See also discussion of these claims as well as claims 27-28 infra. Due to the lack of clarity with regard to claim 5, the “surface” is interpreted as that of the grip area.

Claim Rejections - 35 USC § 102

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-3, 5-15, and 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Long et al ‘389.

Claim 1: See the Claim Language Interpretation section supra, hereinafter also referred to as CLI, and ‘389 at the Figures and col. 3, lines 53 et seq, col. 15, lines 14-43, col. 16, lines 50-60, esp. line 60, col. 16, line 61-col. 17, line 31, col. 17, line 60-col. 18, line 16, col. 18, lines 32-59, col. 20, lines 17-60, col. 22, line 22-col. 23, line 18, col. 23, lines 53-56, i.e. ‘389 teaches a fastening tape 36 for a hygiene item 10 which is a diaper having a fastening area, e.g. adjacent 38, for permanent fastening on the hygiene item and having a closing area 56 for simultaneous detachable joining to a surface of the hygiene item, a protruding section, e.g. adjacent 90, see, e.g., Figures 5-6, between the closing area and a tape end adjacent to the closing area, 90, wherein the protruding section has a “separate” grip area, see CLI, 54 and, e.g., col. 23, lines 53-56 (It is noted that the claim language “separate grip area” does not require individual pieces of material, only spacing), having a surface with a “macroscopic” structure (It is noted that the claim only requires the surface have some, i.e. “a”, structure, which is macroscopic”, i.e. “large enough to be perceived or examined without instrumentation, esp. as by the unaided eye” (emphasis added), i.e. requires only some type of non-instrumental perception at a minimum, see CLI and, e.g., col. 22, lines 22-59 and Figures. It is the Examiner’s first position that ‘389 explicitly teaches a surface having a “macroscopic” structure. In any case, i.e. the Examiner’s second position, since ‘389 teaches all the claimed structure and/or the dimensions, shapes and/or colors of the grip area, there is sufficient factual evidence for one to conclude that such area also inherently includes the same function thereof, i.e. surface having a structure which is “macroscopic”. Claim 1 now requires a separate grip area having no remaining hooks, as best understood, see CLI supra and, e.g., col. 20, lines 32-51 of ‘389, i.e. the end product has a

separate grip area with no remaining hooks, e.g. 100% of the hooks have been deactivated by melting or filling in.

Claim 2: The separate grip area has a structurally separate component, see again col. 23, lines 53-56.

Claim 3: The structurally separate component is a film, see CLI, and, e.g., col. 16, lines 42-49, and thereby '429 at col. 16, lines 21-22, '389 at col. 23, lines 12-13 and col. 20, lines 38-51.

Claim 5: See CLI supra and the structured surface has embossing, see col. 20, lines 38-60, especially lines 44-46 (It is noted that "emboss" is defined as "to decorate with or as if with a raised design").

Claim 6: The embossing has a plurality of straight and/or curved lines, some of which are "joined" together, i.e. at least indirectly, see CLI and note "joined" includes either direct or indirect joining and the discussion of claim 5.

Claim 7: The grip area is arranged on a grip edge of the protruding section, see, e.g., portion of 54 adjacent 90 in Figures 5-6B.

Claim 8: The grip area is arranged with an offset to a tape end of the protruding section, e.g. the portion of 54 remote from 90 in Figures 5-6B or see 41 of 54 in Figure 10 (It is noted that the claim does not require the entirety of the grip area be offset).

Claim 9: The grip area is designed in strips and runs, at least in part, essentially along a grip edge and/or a tape end in its shape, e.g., 41 in Figures 5 and 6 adjacent 90, or alternating 41 in Figure 10, or col. 20, lines 52-60, col. 16, lines 50-60, col. 17, lines 8-30 and col. 18, lines 3-16 and 32-59.

Claim 10: The grip area runs in a meandering pattern, see discussion of claim 9.

Claim 11: The grip area is approximately the same distance from the closing area as from a tape end, see, e.g., the Figures, e.g. 41 in Figure 7 (It is noted that the specific portion of the grip which is so distanced has not been specifically claimed nor is such distance required to be greater than 0).

Claim 12: Only an inside of the fastening tape has a grip area, see, e.g., Figure 1 and Figures 5A-5B.

Claim 13: Only an outside of the fastening tape has a grip area, see Figures, the discussion of claim 12, the paragraph bridging cols. 14-15, col. 16, lines 18-28, i.e. 50 on the body facing/inward side and 54/56 on garment facing/outward side of 36 or see Figures and note that the claim does not require the outside be the garment facing side, i.e. the outside/tape end of the tape has a grip area.

Claim 14: Both sides of the fastening tape have a common grip area and/or separate grip areas, see, e.g., Figure 11-11A, elements 54 and 102 and col. 22, lines 54-65 or note that the two sides can be, e.g., upper and lower sides/halves of the same surface and Figure 9, element 54.

Claim 15: Two identically shaped and sized grip areas are provided on the two sides of the fastening tape, see, e.g., 54 in Figures 4, 5 and 6 and 102 in Figure 11 or the upper half of 54, i.e. on the upper side of line 9A-9A, and the lower half of 54, i.e. on the lower side of line 9A-9A (It is noted that the grip areas are not required to be spaced or spaced a particular distance from each other).

Claim 24: The closing area comprises a plurality of hooks 40.

Claim 26: See discussion of claim 1 and Figure 1.

Claim 25: The hygiene item closing area comprises a plurality of hooks 40 and the hygiene item further comprises a frontal tape 50 on an outside surface of the hygiene item, the frontal tape comprising a plurality of loops, see col. 16, lines 3-16, corresponding to the hooks, the hooks and loops forming a two component fastening system.

Claims 27-28: See CLI, note that the claims do not specifically set forth how the material is “different”, and then discussion of claims supra, esp. 1-2 and 26, i.e. ‘389 teaches individual, separately provided sections or pieces, i.e. “different”/not the same as claimed.

Claim Rejections - 35 USC § 102/103

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 4 and 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Long et al ‘389.

Claim 4 requires the grip area be designed “like a film” and claim 16 requires two separate “film-like” grip areas having different macroscopic structures, see CLI and the discussion of the claims supra, esp. claims 1-2, 14-15 and ‘389 at col. 22, lines 21-53, 59-65 and the paragraph bridging cols. 22-23. Therefore it is the Examiner’s first position that ‘389 teaches a grip area “like a film” or two “film-like” grip areas as claimed with “sufficient specificity”, see MPEP 2131.03, i.e. the area is at least eight times the thickness. Even if ‘389 is not “sufficiently specific”, since the ranges of the ratios of area dimensions with respect to thickness dimensions of ‘389 “overlap or lie inside” claimed ranges, see CLI, (In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The

prior art taught carbon monoxide concentrations of “about 1-5%” while the claim was limited to “more than 5%.” The court held that “about 1-5%” allowed for concentrations slightly above 5% thus the ranges overlapped.); In re Geisler, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997) (Claim reciting thickness of a protective layer as falling within a range of “50 to 100 Angstroms” considered prima facie obvious in view of prior art reference teaching that “for suitable protection, the thickness of the protective layer should be not less than about 10 nm [i.e., 100 Angstroms].” The court stated that “by stating that suitable protection’ is provided if the protective layer is about’ 100 Angstroms thick, [the prior art reference] directly teaches the use of a thickness within [applicant’s] claimed range.”)), or do not overlap but are close enough to the claimed ranges that one skilled in the art would have expected them to have the same properties (Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of “having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium” as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium)), a prima facie case of obviousness exists. See MPEP 2144.05.

Response to Arguments

15. Applicant’s remarks have been carefully considered but are either deemed moot in that such have not been reraised or deemed not persuasive. For example Applicant’s remarks with respect to the prior art rejection are of different scope/inconsistent with the claim language and specification as discussed supra.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The '032 reference also teaches disclosed and/or claimed features of the invention of the instant application.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Karin M. Reichle/
Primary Examiner, Art Unit 3761

July 15, 2009

